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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

FS-00504 (02890033AA)

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Application Number

09/692,538

Filed

10/20/2000

First Named Inventor

J. Moody

Art Unit

2635

Examiner

N. Nguyen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 33,138

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____


Signature

Marshall M. Curtis
Typed or printed name

(703) 787-0400
Telephone number

March 8, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

John O. Moody et al.

Confirmation No.: 3407

Serial No.: 09/692,538

Group Art Unit: 2635

Filed: October 20, 2000

Examiner: N. Nguyen

For: ASSET TRACKING USING WIRELESS LAN INFRASTRUCTURE

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ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This Pre-Appeal Brief Request for Review is being concurrently filed in the USPTO with a Notice of Appeal. If any additional fees are required to satisfy the fees due for the Notice of Appeal or to gain entry and consideration of this Pre-Appeal Brief Request for review, the Commissioner is authorized to charge any such additional fees to Attorney's Deposit Account 50-2041.

No amendments are submitted herewith in response to the Final office action mailed December 8, 2005.

The Invention

The invention was summarized in the remarks appended to the most recent response filed September 12, 2005, as follows:

The invention is directed to a transponder and system including a transponder which takes advantage of the properties and functions of wireless local area networks (WLANs) and the infrastructure contained in them and includes use of commercially available mobile devices already interoperable with them as well as the transponders which may be attached to objects and which are specially adapted (simply by arranging for them to communication using a WLAN protocol) to also interoperate with and be recognized by the WLAN. The

invention takes advantage of the fact that the access points (AP) of a WLAN normally detects the presence of nearby equipment such as mobile computers and that the physical location of the access points is *a priori* known to the WLAN. Therefore, by arranging transponders to communicate using standard WLAN protocols, the WLAN is enabled to detect and thus track the transponders in the same manner as detecting other devices which are interoperable with the WLAN system using the infrastructure already available within the WLAN *but which was not originally designed for such a purpose*. In short, the invention derives a function much like that of a radio frequency identification (RFID) system in addition to that of the WLAN from the existing WLAN infrastructure as well as additional useful functions as a consequence of doing so, such as increased precision of location detection (e.g. by processing via various algorithms of data collected from multiple access points of the WLAN) and periodic determination of condition or status of the objects tracked.

Errors and Omissions

It is respectfully submitted that the Examiner has not yet addressed the *concept* of the invention which is to provide a transponder which can be associated with a device and which the *existing* network infrastructure including wireless links can track as to at least location such that (as recited in claim 6) the *existing* network infrastructure can provide reports in regard to the devices with which the transponders are associated. The Examiner principally relies upon three passages of Meier: column 1 line 66 to column 2, line 16; column 3, lines 20 - 45; and column 8, lines 23 - 59. The first of these passages is directed to the purpose of the invention of Meier to avoid loss of communications during roaming by wireless terminals and is silent in regard to transponders. This passage also refers to the use of "protocol tunnels" to route communications "via the wired network, thereby preserving communications while roaming by allowing the wireless terminals to retain their wired network addresses" (column 2, lines 10 - 14). The second of these passages is also completely silent in regard to "transponders" but refers throughout to portable terminals and, perhaps more importantly, to their ability "to roam from one access point (OWL AP) to another in a manner which is *transparent* to higher level protocols" (lines 31 - 32, emphasis added). The third of these passages is apparently relied upon for the statement therein that the "mobile IP terminal may be any device which contains a radio transceiver" and includes, as an example, an "RF TAG". These passages, taken together and in the context of the remainder of the disclosure of Meier appear to suggest adapting a

network including wireless links to detect RFID tags in order to maintain communications therewith using the same “wired network addresses” rather than the converse of providing simple transponders of a complexity similar to RFID tags which can then be identified and tracked as to location and other information, such as device condition, by the infrastructure of the *existing* network, as claimed, by the language:

“means, responsive to said receiving of said interrogation signal, for transmitting a signal *in accordance with a wireless network protocol* that can be received by an access point of said standard data network and interpreted by an access point of said standard data network as identification information” (claim 1, emphasis added)

and

“a transponder detectable by said wireless access points of said computer network, said transponder including means for transmitting identification information corresponding to said transponder *in accordance with a wireless network protocol* in response to an interrogation signal, and

“means for accessing and reporting internal network access point information in association with said identification information” (claim 6, emphasis added).

Moreover, by providing “protocol tunnels...via the wired network” to maintain communications using the retained “wired network addresses”, it appears that Meier obscures location information which is the information of interest in the present invention and thus teaches directly away from the present invention. In this regard, it should be noted that the interrogation signal, in accordance with the invention as claimed need not be in accordance with any network protocol or be specific to any transponder but may be broadcast and it is only the response transmission by the transponder that is to be in accordance with a (standard) network protocol to identify the transponder through reception at one or more respective access points such that at least location may be tracked by the existing network infrastructure. Instead, it appears that Meier provides protocol tunnels so that an RFID tag can be interrogated from an *a priori* known access point.

The basic deficiencies of Meier to answer the basic *concept* of the present invention, as claimed, is not mitigated by the secondary reference to Flach et al., as discussed in detail at pages 6 - 9 of the response filed September 12, 2005, which is hereby fully incorporated by reference herein. In summary, Flach et al. is

even farther afield from the basic concept of the invention by providing a *separate system* for the communication provided by the network infrastructure in accordance with the invention and then interfacing *that separate system* with a network. Therefore, the combination of Meier and Flach et al. do not and cannot provide evidence of a level of ordinary skill in the art would support a conclusion of obviousness of the claimed subject matter or lead to an expectation of success in tracking location of devices by tracking transponders transmitting identification information in accordance with a network protocol using *existing or standard* network infrastructure (e.g. deriving a function from the network that the network would not ordinarily provide, see pages 3 - 4 of the original specification, particularly lines 24 - 30 of page 3). The combination of Meier and Flach et al. is common to all asserted grounds of rejection and other secondary references do not and are not asserted, by the Examiner, to address this deficiency of the basic combination of Meier and Flach et al. as discussed in the above-incorporated response and earlier responses which are also hereby fully incorporated by reference. Accordingly, it is clear that the asserted grounds of rejection are clearly in error and the Examiner has not, in fact, addressed the basic concept of the invention.

Conclusion

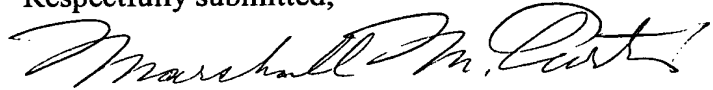
Since there are features explicitly recited in each of the claims which are absent from the references relied upon, no combination of the reference would provide the recited features. Neither do the references relied upon by the Examiner provide any evidence of a level of ordinary skill in the art that would support a conclusion of obviousness in regard to the claimed differences between the claimed subject matter and the prior art or lead to an expectation of success in providing the meritorious functions of the invention by provision of a transponder, as claimed, which communicates identification information over a wireless link using a standard network protocol, when interrogated. The claimed invention is not an adaptation of a network to communicate with any known form of an "RF TAG", as is Meier, but a transponder, distinct from an RF TAG by virtue of responding to interrogation by transmitting identification information in accordance with a network protocol, and a system including it which allow additional novel and unexpected functions to be derived from an existing and/or standard network. None of the prior art relied upon contains any suggestion of such a *concept* or derive such meritorious functions as a result thereof. Moreover, no *prima facie* demonstration of the propriety of any of the asserted grounds of

rejection has been made by the Examiner, but only *an approximation of a reconstruction* clearly relying upon impermissible hindsight which still fails to answer the explicit recitations of the claims.

In view of the above, it is requested that the position taken by the Examiner be reviewed, that the asserted grounds of rejection be withdrawn, and that the application be allowed at an early date.

If an extension of time is required for this paper to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Marshall M. Curtis". The signature is fluid and cursive, with the first name "Marshall" being the most prominent.

Marshall M. Curtis
Reg. No. 33,138

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